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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,198	06/20/2001	Augustin T. Chen	393325	5726
7590	04/15/2004		EXAMINER	
Kenneth D. Goetz Lathrop & Gage, LC Suite 2800 2345 Grand Boulevard Kansas City, MI 64108			SASTRI, SATYA B	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 04/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/885,198

Applicant(s)

CHEN ET AL.

Examiner

Satya B Sastri

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22, 24, 27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 24, 27 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to the amendment filed on March 9, 2004. *Claims 22, 24, 27 and 29* are now pending in the application. The examiner has carefully considered the arguments presented by the applicant but not found persuasive and the rejections cited in the previous office action are sustained.

### *Response to Arguments*

2. Applicants argue that the present invention is in regard to an aqueous adhesive whereas the prior art to Morris et al. (US 5,514,122) teaches a disposable absorbent article having hollow polymeric microspheres produced using a non-free radically polymerizable acid. The prior art disclosure does exclude solid polymeric microspheres and teaches that solid microspheres may be prepared by a "one-step" emulsification process comprising an aqueous suspension polymerization of the free radically polymerizable monomer(s), at least one hydrophilizing component, an emulsifier or suspension stabilizers, optionally at least one polar monomer, oil soluble initiator(s), optionally crosslinkers, and other optional additives in an aqueous or other polar solution. Methods for suspension polymerization include these described in patents such as U.S. Pat. Nos. 3,620,988; 4,166,152; 4,495,318; 4,598,112; 4,810,763; DE 3,544,882; 4,786,696 or 4,645,783. The suspension can be stabilized by polymeric stabilizers, include those described in U.S. Pat. No. 4,166,152 (Baker et al., including but not limited to

Art Unit: 1713

casein, crosslinked polyacrylic acids, polyoxyethylene, polyacrylic acid, polymethacrylic acid, polyacrylamide, polyvinyl pyrrolidone, polyethylene amine, polyvinyl methyl ether, polyvinyl alcohol, salts thereof, and mixtures thereof). Polymeric stabilizers or mechanical agitation can be used alone or in conjunction with ionic or nonionic surfactants or emulsifiers. Preferred are suspension polymerization processes using ionic or nonionic emulsifiers at a concentration greater than the critical micelle concentration (column 4, lines 58-68 and column 5, lines 1-12). Thus, the prior art teaches the process of making solid microspheres and admits the same as known prior art.

3. Applicants contend that Morris et al. do not teach the adhesive composition and the article as claimed in the present invention. The prior art discloses articles comprising **pressure-sensitive adhesive compositions comprising matrix or binder and polymeric microspheres**. The matrix or binder is based on free radically polymerizable acrylate such as isooctyl acrylate, isononyl acrylate, n-butyl acrylate, hexyl acrylate etc. (column 6, lines 42-53). The disclosure further includes that for obtaining superior cohesive strengths, the adhesive matrix may be crosslinked with multiacrylates (column 7, lines 46-51). **The adhesive may comprise 1 to 60 parts of a water dispersible acrylate microsphere and 99 to 40 parts of aqueous latex as adhesive matrix (column 15, lines 39-58, claim 1)**. In this prior art, the weight ratio, on a solids basis, of microspheres to crosslinked acrylate polymer ranges from about 0.04:1 to about 2:1 (column 11, Table I).

4. Present claims are product by process claims wherein the microspheres are made a process different than that disclosed in the prior art. However, applicants have not provided

Art Unit: 1713

evidence for the claimed process to yield a product that differs from prior art product by way comparative studies. Where product by process claims are rejected over a prior art product, the burden is shifted to applicants to establish unobvious difference, even if production processes are different unless applicants show criticality of the process involved. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

5. With regard to applicants' remark that the prior art does not teach or suggest any dry peel value, a reasonable basis exists that the properties would be the same given the similarity in the adhesive compositions. It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980). Applicants have not provided objective evidence that the adhesive compositions are different from prior art compositions.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1713

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at telephone number is (571) 272-1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272-1114.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at (703) 308-0661.

*satya sastri*

SATYA SASTRI

April 6, 2004

*David W. Wu*

DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700